

01 AUG 2006



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Nuvello Inc  
675 Almanor Avenue  
Sunnyvale CA 94085

In re Application of	:	
RUPP et al.	:	
Application No.: 10/520,299	:	
PCT No.: PCT/US03/21703	:	
Int. Filing Date: 09 July 2003	:	DECISION
Priority Date: 12 July 2002	:	
Attorney Docket No.: HYS-B2CIP/US	:	
For: METHODS AND MATERIALS RELATING TO	:	
NOVEL POLYPEPTIDES AND POLYNUCLEOTIDES	:	

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 14 October 2005 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 09 July 2003, applicants filed international application PCT/US03/21703, which designated the United States and claims a priority date of 12 July 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 22 January 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 12 January 2005.

On 04 January 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, an assertion of small entity status, and the surcharge under 37 CFR 1.492(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage.

On 18 August 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 14 October 2005, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a copy of a letter from Renee Polizotto to nonsigning inventor Tom

Wehrman, a copy of proof of delivery of a package mailed via Federal Express, copies of e-mails from Renee Polizotto to Tom Wehrman, and copies of e-mail receipts for these e-mails.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee of \$200 has been charged to Deposit Account 50-1169. Accordingly, item (1) has been met.

Item (2) has been met as well.

As to item (3), the last known address of the nonsigning inventor should be the inventor's most recent home address. MPEP § 605.03 ("the inventor's most recent home address must be given in order for the Office to communicate directly with the inventor as necessary"). The address provided appears to be a business address rather than a home address. If this address is not a business address or if the address provided is the address where the nonsigning inventor customarily receives mail, applicants should notify this Office immediately in any Request for Reconsideration. Otherwise, applicants must send the application to the last known address where the nonsigning inventor customarily receives mail and provide this address in any Request for Reconsideration.

Item (4) has not been met. The declaration of inventors filed 14 October 2005 is not in compliance with 37 CFR 1.497(a)-(b). There is a difference in names in the last-named inventor between the published international application (Y. Tom Tang) and the declaration of inventors (Yuanhua T. Tang). Because this difference in names is more than a mere typographical error or a phonetic misspelling of applicant's legal name, a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of \$400 as well as a statement from the inventor. This statement should set forth that he is a joint inventor of the subject matter of the present application and should set forth the circumstances surrounding the difference in names on the international application and the declaration.

### **CONCLUSION**

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response, must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should

include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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